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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,696	07/10/2000	Alan G. Wood	91-62.20	9107

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STEPHEN A GRATTON
THE LAW OFFICE OF STEVE GRATTON
2764 SOUTH BRAUN WAY
LAKEWOOD, CO 80228

EXAMINER
KARLSEN, ERNEST F

ART UNIT	PAPER NUMBER
2829	

DATE MAILED: 05/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NP

Office Action Summary

Application No.	Applicant(s)
09/612696	WOOD ET AL
Examiner	**Group Art Unit**
E. KARLSEN	2829

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 2-4-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 34-41, 42, 43-46 is/are pending in the application.

Of the above claim(s) 42 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 34-41, 43-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. Claim 42 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 5 and 7.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 34-41 and 43-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 5,302,891. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 34-41 and 43-46 are broader in scope than claims 1-43 of U.S. Patent No. 5,302,891.

4. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The only portion of the specification that relates to the embodiment of figure 8 is the last 6 lines on page 11 of the specification. No mention of a first plate, a second plate, plastic film, test circuitry, conductive trance, bumps, electrical connector trace, direct electrical path, polyamide, plastic film, die receiving cavity, elastomeric biasing member, compressible elastomeric pad, solder, a connector providing an electrical path independent of the first plate and the second plate, metal, a cavity for retaining the die or the first plate includes a cavity and a spacer member within the cavity is present in the last 6 lines of page 11 of the specification and all of the listed terms are considered to be without basis in the specification. This rejection was applied previously and applicants responded with argument that one of ordinary skill would be able to construct and use the apparatus of figure 8 based on disclosure directed to other figures as set forth in the remarks of the amendment of February 4, 2002. The level of one of ordinary skill in the art seems to be at issue. In attempting to establishing adequacy of disclosure applicants maintain that one ordinarily skilled in the art could figure out how to make and use the apparatus of figure 8 from the rest of the disclosure. The examiner maintains that one of ordinary skill would not be able to do so. The examiner, in other rejections has asserted that one ordinarily skilled in the art would, having been shown a device for testing a one of a wafer or a die, be able to figure out how to adapt the device for testing the other of a wafer or a die especially when told that the device can be adapted to test the other of a wafer or a die. Applicants disagree with such assertion arguing that one of ordinary skill in the art would not be able to do so. It is noted that a wafer might have only one die on it. In such a case implementation would appear pretty straight forward. The examiner maintains one

of ordinary skill in the present art would not be able to construct a usable version of figure 8 from the disclosure.

5. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The only portion of the specification that relates to the embodiments of figure 8 is the last 6 lines on page 11 of the specification. It is not clear what the parts of figure 8 are or how they are assembled. The arguments with regard to this rejection are basically the same as those of the above rejection set forth in paragraph 4. Also the argument regarding skill level of one of ordinary skill in the art apply.

6. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what all the claimed elements are and it is not clear how they are interconnected and interrelated to produce the desired results. The reasons for the lack of clarity stem from insufficient disclosure as set forth in paragraphs 4 and 5.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 34-41 and 43-46 are, insofar as understood, are rejected under 35 U.S.C. 102(b) as being fully anticipated by any one of Kattner et al, Enochs, Jamison et al, Greub et al, Littlebury et al, Malhi et al, Elder et al '850 or Item 32636 of the Research Disclosure No. 326 cited by applicants as Item U. The test of wafers, die and multichip hybrids are considered equivalent. For support of the above statement see Elder et al '850. Note also that Enochs uses polyamide film. That which is tested by Jamison et al is considered equivalent to a die. Applicants have argued that the above seems to be a combination of references. Equivalents are applicable under 35 U.S.C. 102. Reading claim 34 on Littlebury for instance, would read as follows; Die and wafers are equivalent. Looking at figure 1 of Littlebury et al, chamber 14 has a top and bottom. The bottom supports element 18 which is a first plate. The top is a second plate. Element 12 is a tape. One end of tape 12 has a connector.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 34-41 and 43-46 are, insofar as understood, rejected under 35 U.S.C. 103(a) as being unpatentable over any of Kattner et al, Enochs, Jamison et al, Greubg et al, Littlebury et al, Malhi et al, Elder et al '850 or Item 32636 of the Research Disclosure No. 326 cited by applicants as Item U.

It is considered obvious to one of ordinary skill in the art to adapt a device for testing wafers to a device for testing die. A die is merely a part of a wafer and a wafer is just plural dies although a wafer could have only one die and then the wafer and die would be equal. A device is what it is and not what it does, and thus design for chip or wafer test is irrelevant. Even if not irrelevant ample information to establish equivalence exists. The Research Disclosure reference and Elder et al '850 both teach equivalence. Without really knowing if the Research Disclosure reference has a good date it is maintained as a reference. The Research Disclosure reference has decal wiring which is considered the same as printed circuit wiring. The words are different than used by applicants but the concept is the same. The flexible contractor of the Research Disclosure reference is considered equivalent to a tape comprising plastic film. Regarding die, wafers and modules as equivalent, since a device is what it is and not what it does claim 34 can be read on Janison et al as follows: Element 20 is a first plate. Element 30 is a second plate. Element 50 is a tape and elements 55 are connectors.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --

13. > (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

14. Claims 34-41 and 43-46 are, insofar as understood, rejected under 35 U.S.C. 102(e) as being fully anticipated by Item 32636 of the Research Disclosure No. 326 cited by applicants as

Item U. The terms used in the Research Disclosure reference are considered the British version of applicants' terms.

Karlsen/ds

04/24/02.

ERNEST KARLSEN
PRIMARY EXAMINER